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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/806,955	07/11/2001	Gabriel Stavros Panayi	78104.023	2246

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EXAMINER

JAMROZ, MARGARET E

ART UNIT

PAPER NUMBER

1644

DATE MAILED: 12/20/2001

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/806,955

Applicant(s)

PANAYI ET AL.

Examiner

Margaret E Jamroz

Art Unit

1644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 18-53 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: *restriction election facsimile*.

Art Unit: 1644

DETAILED ACTION

1. The Art Unit location and the examiner of your application in the PTO have changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Megan Jamroz, Art Unit 1644, Technology Center 1600.
2. Applicant's amendment, filed on 7/12/00 (Paper No. 5), is acknowledged.
Claims 18-53 are pending and being acted upon presently.

Election/Restrictions

3. Restriction is required under 35 U.S.C. 121 and 372.
This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.
4. In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I, claims 18-19, 22-25, and 44-53, drawn to a recombinant immunoglobulin heavy chain binding protein, a pharmaceutical composition, and a kit.

Group II, claims 20-21 and 26-29, drawn to an isolated DNA molecule, a vector, and a pharmaceutical composition.

Group III, claims 30-34, drawn to a method for treating inflammation comprising administering a recombinant immunoglobulin heavy chain binding protein.

Group IV, claims 35-39, drawn to a method of treating inflammation comprising administering DNA.

Group V, claims 40-43, drawn to a method for diagnosing the presence of rheumatoid arthritis.
5. The inventions listed as Groups I-V do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The invention of Group I was found to have no special technical feature that defined the contribution over the prior art of Ting et al, (DNA 7:275-286 (1988); see entire document), NCBI Protein Accession No: P11021, Hsu et al. (Protein Expression and Purification, (1994) Vol. 5, No. 6, pp. 595-603), Witzmann et al. (Fundamental and Applied Toxicology, (1994) Vol. 23, No. 1, pp. 1-8), Haas et al. (PNAS, (1988) 85 (7), 2250-2254), and Kozutsumi et al. (JOURNAL OF CELL SCIENCE. SUPPLEMENT, (1989) 11 115-37).

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Ting et al. and P11021 teach a recombinant human gene encoding the 78-000-Dalton Glucose-related Protein and Its Pseudogene: Structure, Conservation, and Regulation; which is a recombinant immunoglobulin heavy chain binding protein. The amino acid sequence SEQ ID NO: 2 of the instant application is 98% identical to the protein taught by the references and differs only in that the first and last amino acid residues of SEQ ID NO: 2 differ from the reference sequence.

Hsu et al., Witzmann et al, and Haas et al. teach recombinant BiP, which is a recombinant immunoglobulin heavy chain binding protein.


Kozutsumi et al. teach a recombinant GRP78, a recombinant immunoglobulin heavy chain binding protein, which was identified based upon homology with BiP.

Since Applicant's inventions do not contribute a special technical feature when viewed over the prior art they do not have a single general inventive concept and so lack unity of invention.

6. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Megan Jamroz, whose telephone number is (703) 308-8365. The examiner can normally be reached Monday to Friday from 8:00 to 4:30. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached at (703) 308-3973. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-0196.

Papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center telephone number is (703) 305-3014.

Margaret (Megan) Jamroz, Ph.D.
Patent Examiner
Technology Center 1600
December 18, 2001


PATRICK J. NOLAN, PH.D.
PRIMARY EXAMINER
12/18/01